REMARKS

[0001] In the Office Action, claims 1-48 are pending in the case. The Examiner rejected Claims 1-47 under 35 U.S.C. §112, 2nd paragraph for indefiniteness. The Examiner rejected Claims 1-16, 19-35, 38-45, and 48 under 35 U.S.C. §103(a) in view of what the Examiner asserts is Applicant's Admitted Prior Art in view of U.S. Patent No. 5,758,333 to Bauer et al. (hereinafter "Bauer"). The Examiner allowed Claims 17-18, 36-37, and 46-47 if amendments are made to overcome the rejections to the respective independent claims. In view of the amendments and following remarks, reconsideration and allowance of claims 1-48 is respectfully requested.

REJECTION OF CLAIMS 1-47 UNDER 35 U.S.C. 112, 2nd PARAGRAPH

[0002] The Examiner rejected Claims 1-47 under 35 U.S.C. §112, 2nd paragraph for indefiniteness. Applicant traverses certain aspects of this rejection for which no amendments have been made.

[0003] The standard for definiteness is whether the claims, "read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention" the claims are definite. Hybritech Inc. v. Monoclonal Antibodies, 231 U.S.P.Q. 81 (Fed. Cir. 1986). The standard does not require that the term be explicitly clear from the claim language alone. Applicant submits that certain terminology in Claims 1-47 is sufficiently definite in view of this standard as described below.

[0004] Regarding Claims 1, 20, and 38 and the term "an actual PCB," Applicant respectfully asserts that such language is sufficiently definite when "read in light of the specification." *Id.* The term actual PCB is used to explicitly distinguish "an actual PCB" from a "first candidate PCB" and a "second candidate PCB" recited respectively in Claims 14 and 17.

Applicant submits that use of the term "PCB" may be confusing and indefinite once subject matter of the independent claims, such as Claim 1 is considered together with Claims 14 and 17. Furthermore, the specification clarifies for one of skill in the art that "an actual PCB" differs from a "candidate PCB" in that a "candidate PCB" may comprise a pointer to "an actual PCB." See Specification page 11, lines 8-9, lines 19-20. Based on this description, those of skill in the art understand the difference between a data structure and a pointer to the data structure.

[0005] Regarding Claims 1-3, 6-22, and 25-44, the Applicant has amended these claims to specify the meaning of the abbreviations. Regarding Claims 9-10, 13, 19, and 22, Applicant has amended these claims to address the Examiner's rejections. Regarding Claim 42, Applicant notes that the Examiner references the rejection of Claim 19, however, claim 42 has no "characteristics" term. Applicant has presumes the Examiner intended to refer to the rejection of claims 9-10 and 13. Consequently, Applicant has made an amendment to clarify the dependency in Claim 42.

[0006] The Applicant has amended Claims 1, 3, 6, 8-10, 13, 16, 19, 20, 22, 25, 27, 28, 38, 40-43, and 46 in order to particularly point out and distinctly claim the subject matter which the Applicant regards as his invention and address other informalities. Accordingly, Applicant respectfully requests that the rejection of Claims 1-47 under 35 U.S.C. §112, 2nd paragraph be withdrawn.

REJECTION OF CLAIMS 1-16, 19-35, 38-45, AND 48 UNDER 35 U.S.C. §103(a)

[0007] The Examiner rejected Claims 1-16, 19-35, 38-45, and 48 under 35 U.S.C. §103(a) in view of what the Examiner asserts is Applicant's Admitted Prior Art in view of Bauer. Applicant respectfully traverses this rejection.

[0008] Under 35 U.S.C. §103 the Examiner has the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the combination of the prior art references must teach or suggest all the claim limitations. MPEP § 2142. In addition, "it is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor." *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934 (Fed. Cir. 1990).

[0009] Applicant asserts that a *prima facie* case of obviousness has not been made because what the Examiner asserts is Applicant's Admitted Prior Art (AAP) combined with Bauer fails to teach or suggest all the elements of the claims.

[0010] Use of admissions as prior art is controlled largely by case law. MPEP §2129 provides specific guidance for the Examiner on this matter. See MPEP §2129, Rev. 2 May 2004. In particular, if the specification "identifies work done by another as "prior art," the subject matter so identified is treated as admitted prior art." See MPEP §2129(II).

[0011] Applicant respectfully submits that references to work done by others as "prior art" is limited to discussion in the background section (See pages 1-5) and a reference on page 16

lines 8-11. The subject matter in these areas fail to teach or suggest all the elements found in the claims. Therefore, the Applicant has not admitted prior art that can be used in an obviousness rejection of the claims.

[0012] In particular, the Examiner recites that the AAP teaches two elements of Claim 1 by referring specifically to page 6, lines 4-10 of the Applicant's specification. See Office Action page 3. Applicant notes that page 6, lines 4-10 are within the "Summary of the Invention" section of the patent application. Applicant respectfully asserts that such subject matter is clearly not a reference to work done by others that can be characterized as an admission usable as prior art. Instead, subject matter in the "Summary of the Invention" section summarizes what the Applicant considers his invention, his own work. Therefore, the subject matter referred to as the Applicant's Admitted Prior Art is not prior art.

[0013] The Examiner relies largely on the alleged AAP in rejecting Claim 1. As indicated, this subject matter is not prior art. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness.

[0014] "If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." MPEP §2142. Further discussion of obviousness or evidence is moot in view of the fact that the Examiner has not established a *prima facie* case.

[0015] Nevertheless, the Applicant would like to explain the distinctive features of the present invention from that of the cited prior art in order to expedite allowance of the application. Bauer teaches a system that inserts an application procedure layer "VIEW" between the application layer and the user module layer. See Bauer Col. 5, Lines 8-21. Previously, users

built their own data modules for addressing and accessing data. See Bauer Col 1, lines 25-30. Bauer allows the application to be independent of the logical data structures. See Bauer Col. 5, Lines 8-21.

[0016] In contrast Claim 1, recites: "(a) locating an actual Program Communication Block (PCB) associated with said at least one IMS resource exclusive of predetermined knowledge pertaining to an IMS construct form, and (b) utilizing said actual PCB to perform said one or more form independent application program operations on said at least one IMS resource." The claimed invention relates specifically to locating of PCBs in relation to IMS and IMS resources.

[0017] "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). *MPEP* §2143.03. Each of the claim terms are to be given their reasonable meaning. The terms "IMS" and "PCB" were purposefully selected by the Applicant. Applicant finds no reference to "PCB" or "IMS" in Bauer. IMS is a well know hierarchical database management product available from IBM. Those of skill in the art readily recognize that the claimed invention relates specifically to IMS. There is no teaching or suggestion in Bauer regarding locating of a PCB for an IMS resource.

[0018] As explained in the specification, the ability to selectively locate and/or access multiple sets of PCBs saves considerable costs in terms of time and development work. See Specification Page 6, lines 15-19. The present invention does not require any information about the IMS construct forms.

[0019] The Examiner asserts that Bauer teaches "...said actual PCB to **perform said one or more form independent application program operations** on said at least one IMS resource." See Office Action page 3-4. Applicant respectfully submits that just because Bauer teaches referencing of data blocks through indirection, pointers, (See Bauer Col. 7, Lines 10-20), this does not rise to the level of teaching "**utilizing an actual PCB** to perform said actual PCB to perform said one or more form independent application program operations." Again, Applicant finds no reference to PCBs, nor to utilization of PCBs in Bauer.

[0020] PCBs are proprietary constructs that are closely related to both the IMS application and the IMS databases the IMS application will access. PCBs enable an IMS application to interact with an IMS database. The problem addressed by the claimed invention is that PCBs had to be modified for two independently written IMS applications to interact with the same IMS database. Consequently, compatibility issues arise with regard to PCBs used by the two IMS applications. See Specification page 3, line 21 – page 4, line 7.

[0021] This is one of the problems the claimed invention resolves. Using the claimed invention, multiple IMS applications can interface with the same IMS databases without requiring changes to existing PCBs. The claimed invention provides interoperability between two different IMS applications and a single IMS database without requiring any information about existing PCBs. This is particularly advantageous for IMS utility applications in which obtaining information about the IMS databases used by a particular IMS application may be difficult or impossible to accomplish.

[0022] The claimed invention differs from Bauer because Bauer does not provide any teaching or suggestion for "locating an actual PCB..." Bauer teaches locating of data blocks

using pointers however data blocks are very different from a PCB. Data blocks comprise a data structure that holds data. See Bauer, Col. 7, lines 10-20. As discussed above, a PCB is a program communication block. A PCB comprises control information that effectuates the communication of data from an IMS database to an associated IMS application, not the actual data that is transferred. See PCB definition attached. The PCB when used comprises actual object code used by IMS to communicate the data, not the data itself.

[0023] Finally, neither the AAP nor Bauer teach or suggest combining concepts found in each or the desirability of such a combination. As "[t]he teaching or suggestion to make the claimed combination ... must be found in the prior art, not in applicant's disclosure," MPEP 2143, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991), Applicant submits that AAP fail to provide the requisite motivation to combine to make a *prima facie* case of obviousness.

[0024] For the reasons stated above, Applicants respectfully submit that independent Claims 1, 19, 20, and 38 are patentably distinct from the cited reference. In addition, claims 2-18, 21-38, and 39-48 depend directly or indirectly from the independent claims. Accordingly, Applicants also respectfully submit that these dependent claims are likewise allowable for at least the same reasons.

[0025] In view of the foregoing, Applicant submits that the application is in condition for immediate allowance. In the event any questions remain, the Examiner is respectfully requested to initiate a telephone conference with the undersigned.

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the size of the viewport. When the presentation space is equal to the viewport size, all the data in the presentation space is displayed. When the presentation space is larger than the viewport, the user must move the scrolling window within the presentation space to display the data within the viewport. *See also* viewport.

preset destination mode
An optional mode of terminal operation that allows the destination of terminal input to be fixed as a specific transaction code or logical terminal. It is activated by the /SET command and reset by the /RESET command, the /STOP command, ETO user signoff, static terminal logoff, and an IMS restart.

primary data set group
In a database, the first or only data set group defined. The root segment type always resides in the primary data set group. *See also* secondary data set group.

primary request
In an MSC network, a message entered into a terminal before it is processed. *See also* secondary request and response.

primary session
The session between a class-1 terminal and the active IMS.

primary structure
A coupling facility list structure that contains shared queues or shared resources.

private buffer pool
An area of local storage, used for VSO DEDB data, that can provide lookaside capability for shared VSO areas.

processing intent
An application program attribute, defined in the PSB, that specifies the program's database access privileges such as, insert, delete, and replace.

processing limit
A transaction attribute that defines how many messages the application program is allowed to process during one program execution.

program communication block (PCB)
An IMS control block that describes an application program's interface to and view of an IMS database or, additionally for message processing and batch message processing programs, to the source and destinations of messages. PCBs are defined by the user during PSB generation. *See also* database program communication block (DB PCB) and telecommunication-program program communication block (TP PCB).

program isolation (PI)
An IMS facility that separates all the activity of an application program from any other active application program until that application program indicates, via a synchronization point, that the data it has modified or created is consistent and complete.

program isolation (PI) lock manager
The facility that was formerly known as PI enqueue-dequeue. The PI lock manager is used for local locking in systems for which no IRLM has been defined. Otherwise, the IRLM is used for all lock management, including local.